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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,058	12/17/1998	NED HOFFMAN	STA-14	7856

7590 01/18/2002

SMARTTOUCH INC  
ALI KAMAREI  
46 SHATTUCK SQUARE  
SUITE 12  
BERKELEY, CA 94704

EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
2162	3

DATE MAILED: 01/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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09/215,058 12/17/98 HOFFMAN

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EXAMINER

TM02/0911

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MYHRE, J

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2162

DATE MAILED:

09/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 09/215,058	Applicant(s) Hoffman et al
Examiner James Myhre	Art Unit 2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Dec 17, 1998

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-22 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-22 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      20)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Specification***

1. The spacing of the lines of the specification, abstract, and claims is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

### **Arrangement of the Specification**

2. The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
  - 1. Field of the Invention.
  - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (I) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

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### Content of Specification

3. The following are descriptions of each of the sections designated in the outline above.
  - (a) Title of the Invention: See 37 CFR 1.72(a). The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.
  - (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
  - (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
  - (d) Reference to a "Microfiche Appendix": See 37CFR 1.96© and MPEP § 608.05. The total number of microfiche and the total number frames should be specified.
  - (e) Background of the Invention: The specification should set forth the Background of the Invention in two parts:
    - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
    - (2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
  - (f) Brief Summary of the Invention: A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

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- (g) Brief Description of the Several Views of the Drawing(s): A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. This item may also be titled "Best Mode for Carrying Out the Invention." Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (I) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet. (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps.
- (j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 250 words or less on a separate sheet following the claims.
- (k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.
- (l) Sequence Listing: See 37 CFR 1.821-1.825.

4. The specification is objected to for not including a section entitled "Brief Description of the Several Views of the Drawings" as required by section (g) above. While the specification does contain narrative descriptions of the drawings on pages 5 and 6, these descriptions have been incorrectly entered under the "Detailed Description of the Invention" heading. Correction is required.

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***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 13-18 and 20-22 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3, 6, 7, 11, 14, 16, and 17 of prior U.S. Patent No. 6,154,879. This is a double patenting rejection.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the only difference between claim 1 of the patent and Claim 13 of the instant application is terminology. For example, feature 1c of the patent claims forwarding "the user's bid biometric sample" which is part of the account access request message. Feature 1c of the instant application claims forwarding "the personal authentication information" which is part of the account access request message. However, the personal authentication information had been previously defined in feature 1b as "comprising at least one bid biometric sample". Therefore, the exact same information is being forwarded as part of the account access request message.

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Another example in Claim 1 is identifying the entity with which the user registers as either a “electronic indicator” (patent) or as a “computer system” (application). Since the patent identifies the method as a computer implemented method in the preamble of the claim, it is inherent that the “electronic indicator” is a computer system. Since both of these entities perform the exact same steps in the claimed methods, the Examiner finds no patentable distinction by the use of this alternative terminology.

The other dependent claims are substantially word-for-word duplicates of the patent claims.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 9-1, 20, 21, 24-26, 28, and 29 of U.S. Patent No. 5,870,723 in view of claim 1 of U.S. Patent 6,269,348.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the patent is claiming a method for tokenless authorization of commercial transactions using biometric data by comparing the user's current biometric data with previously stored biometric sample data. There are only two differences between the patented claim 1 and the present claim 1. First, the patent includes the feature of the seller registering not only an account number as in the application, but also a seller identification code. However, in claim 7 of the patent the seller identification code is the same as the seller's account number, therefore eliminating this difference between the claims. Second, the patent includes the feature of the buyer registers not only an account number and biometric sample as in the application, but also a personal identification number (PIN). The Examiner notes that the exclusion of the requirement to register a PIN would have been an obvious variation of the patent. Indeed, in Claim 1 of Patent No. 6,269,348, which claims priority from the above patent, the Applicant only requires the buyer to enter a biometric sample and an account number.

The other dependent claims listed above are substantially word-for-word duplicates of the dependent claims of the patent. The Examiner notes, however, that the parties involved in the transactions are identified using different terminology. In the patent, the parties are identified as the buyer and the seller. In the instant application, they are identified as the user and the seller. Since both sets of terms refer to the two parties involved in a transaction, the Examiner finds no patentable distinction by this use of alternative terminology.

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

9. Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,154,879 in view of Claim 14 of U.S. Patent No. 5,764,789.

As discussed in paragraph 6 above, Claim 13 of the instant application has been rejected as a duplicate of Claim 1 of Patent No. 6,154,879. However, that patent did not claim that the communications within the computer system are encrypted as in Claim 19 of the instant application. The Examiner notes that Claims 11 and 12 of the patent disclose that the communications are being passed over a remote network, such as “the Internet, a private intranet, a telephone network, or a cable TV network”. It would have been obvious to use encryption to securely pass data across these types of unsecure networks, especially when the data is financial in nature. Indeed, in Patent No. 5,764,789 which was filed two and a half years prior to the instant application, the Application explicitly claims encrypting the communications. This patent only distinguishes itself from the present application by the inclusion of a user personal identification number as part of the user identification process.

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***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 3-6, 8, 10, 12, 13, 15-19, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrave et al (6,202,151).

Claims 1 and 13: Musgrave (151) discloses a method for authorizing transactions using biometric identification, comprising:

- a. Registering the user's (customer's) biometric and account data (col 6, lines 42-51);
- b. Adding the customer's current biometric data to transaction offer data upon acceptance of the transaction by the customer (col 5, lines 15-22);
- c. Transmitting the combined data to a remote authentication system (col 5, lines 27-35);
- d. Comparing the transmitted biometric data with the stored registered biometric data to verify the identity of the customer (col 5, lines 53-63);
- e. Transferring the payment between the customer's account and the merchant's account (or another of the user's accounts, e.g. electronic funds transfer from checking account to savings account)(col 6, lines 13-15); and

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f. Presenting the results to the customer, merchant, or both (col 6, lines 13-15).

While Musgrave (151) discloses using this biometric identification system for electronic transactions and banking functions (e.g. ATM terminal)(col 1, lines 32-35) to include transferring funds between accounts, it is not explicitly disclosed that the merchant's account is going to be pre-registered with the system, nor that the merchant proposes a transaction offer to the customer. The Examiner notes that it is common to pre-register merchants and their account numbers with commerce systems for a variety of reasons. For example, pre-registering merchants provides a higher level of assurance to the customer that the merchant is an "approved" merchant that can be trusted to provide the goods/services. Pre-registering merchants also enabled the system to charge a pre-negotiated transaction fee to the merchant, such as is common with credit card transactions. By pre-registering, merchants are also able to complete transactions without having to transmit their account number over unsecure lines (e.g. the Internet) each time. For these and other well known benefits, it would have been obvious to one having ordinary skill in the art at the time the invention was made to register the merchant and to include at least one of the merchant's financial account number. One would have been motivated to include such a registration step for the merchants in the Musgrave (151) invention in view of the reasons above and Musgrave's (151) discussion of the importance of data protection on the Internet.

The Examiner notes that the definition of the merchant's transaction offer in Claim 1, wherein "the proposed commercial transaction comprising price information", reads on a catalogue, an advertisement, sales flyer, or verbal price quote by the merchant. Since almost all

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customers (except, possibly, extremely rich customers) would want to know the price of the goods/services before purchasing the goods/services, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the merchant to present the price of the goods/services to the customer. One would have been motivated to present the price to the customer in order to allow the customer to make a better business decision on the quality of the offer.

Claims 3-6 and 15-17: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claims 1 and 13 above, but does not explicitly disclose using an account code to select an account, assigning a name to the account code, nor displaying a list of the accounts to the customer upon successful identification. Official Notice is taken that it is old and well known within the banking arts to display a list of accounts to a user (such as when operating an ATM terminal) and to identify the accounts using account codes and account names. For example, when a customer logs onto an ATM terminal and selects the type of desired transaction, the terminal will display a list of pertinent accounts and ask the customer to select one or more (depending upon the type of transaction). The list of accounts do not normally show the entire account number, which may be quite extensive in length, but rather the list consists of an account code (e.g. A, B, C, and D) and an associated account name (e.g. checking, savings, Christmas Club, money market). The customer normally selects the desired account by pressing the keyboard button indicated by the account code. A similar system is used to allow a customer to select the desired account when completing a transaction at a merchant's facility, such as a

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travel agency. If the customer has several travel accounts (e.g. business, executive, and personal), the system will display the list of the customer and allow the customer to enter the account code for the desired travel account. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display a list of accounts to Musgrave's (151) customer using account codes and account names and to allow the customer to select the desired account. One would have been motivated to display and use such a list in order to eliminate the need for the customer to remember the lengthy account numbers of each account, thus facilitating a more expeditious selection of the desired account and decreasing the opportunity for erroneous (undesired) selections.

Claims 8 and 18: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claims 1 and 13 above and further discloses the data being communicated between remote computer systems to determine resources and/or construct the credit authorization draft (col 3, lines 40-64).

Claim 10: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claim 1 above, but does not explicitly disclose that the customer can receive cash back during the transaction. The Examiner notes that cash back transactions are extremely well known throughout society and are the major means for many people to maintain their supply of cash-on-hand for small purchases. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the customer in Musgrave (151) to receive cash back during a transaction by entering an amount that exceeds the amount of

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the goods/services being purchased. One would have been motivated to allow a cash back transaction in order to increase customer satisfaction and goodwill and to allow the customer to have the cash to “tip” the merchant representative for exceptional service, provide change for parking meters, etc.

Claim 12: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claim 1 above, and further discloses the type of biometric data being used consisting of one or more of a fingerprint, a retinal image, or voice print (col 4, lines 23-47).

Claim 19: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claim 13 above and further discloses encrypting the messages being communicated within the network (col 5, lines 27-32).

Claim 21: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claim 13 above and further discloses using a biometric sorting number (hash function) to prevent unauthorized access (col 5, lines 15-44).

Claim 22: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claim 13 above, and further discloses the method being used for home banking. It is inherent that in order for a user to conduct home banking that a software application must be executing on his home computer (possibly configured to look like a virtual ATM terminal).

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12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrave et al (6,202,151) in view of Stinson et al (6,045,039).

Claim 2: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claim 1 above, but does not explicitly disclose determining if the customer has sufficient funds in the account. Stinson discloses a similar method for authorizing transactions using biometric identification which also discloses determining if the customer's account has sufficient funds (col 7, lines 60-61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine if the customer's account in the Musgrave (151) invention contained sufficient funds. One would have been motivated to determine this in order to proceed with the electronic funds transfer as disclosed by Musgrave (151).

13. Claims 7, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrave et al (6,202,151) in view of Musgrave (6,105,010).

Claim 7: Musgrave (151)discloses a method for authorizing transactions using biometric identification as in Claim 1 above, but does not explicitly disclose creating a credit authorization draft. The Examiner notes that credit authorization drafts as disclosed by Claim 7 are well known within the business arts and are used extensively in business-to-business transactions to allow transactions to be completed, for example, without the need to pre-approve a transaction in which the final price may not be known ahead of time (i.e. repair of an office machine). Furthermore,

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Musgrave (010), which claims priority from the same provisional applications as the (151) reference, discloses a similar method for authorizing transactions using biometric identification and also discloses creating a credit authorization draft (col 5, lines 35-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to create a credit authorization draft in the (151) reference. One would have been motivated to include the creation of a credit authorization draft in the (151) reference in view of the simultaneous filing of both applications based on the same provisional applications and in order to facilitate business-to-business transactions without overburdening the two accounting departments.

Claim 9: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claim 1 above. While Musgrave (151) discloses including and using the transaction data in the method, it is not explicitly disclosed that the transaction data contains one or more of a list of goods/services, a seller name, a date and time, a location, or an invoice number. The Examiner notes that these are well known elements usually contained in transaction data files. Furthermore, Musgrave (010) discloses a similar method for authorizing transactions using biometric identification, which also discloses the transaction data including goods/services (software or music data - col 4, lines 23-32), location (shipping instructions - col 5, lines 35-42), etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include one or more of these elements in the Musgrave (151) transaction data. One would have been motivated to include these features in order to facilitate delivery of

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the purchased goods/services and to better identify the transaction for accounting processing by all parties concerned.

Claim 14: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claim 13 above and further discloses that the transaction could be banking functions such as an electronic funds transfer or accessing billing records (col 1, lines 30-37 and col 4, lines 57-59). However, the other financial actions described in the claim are not explicitly disclosed. The Examiner notes that these are the normal functions of ATM terminals and home banking services. Furthermore, Musgrave (010) discloses a similar method for authorizing transactions which describes the banking functions as electronic funds transfer, cash withdrawal, paying bills (col 8, lines 20-39), opening accounts, requesting credit history, and others (col 9, lines 28-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include one or more of these actions in the ATM terminal used by Musgrave's (151) customers. One would have been motivated to include these functions in the ATM terminal in order to expand the utility of the terminal to include all of the normal banking functions.

14. Claims 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrave et al (6,202,151) in view of Houvener et al (6,070,141).

Claims 11 and 20: Musgrave (151) discloses a method for authorizing transactions using biometric identification as in Claims 1 and 13 above, but does not explicitly disclose checking for

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duplicate biometric data during the user registration process. Houvener discloses a similar method for authorizing transaction using biometric identification which further discloses checking incoming registration biometric samples against previously stored biometric samples to prevent duplicate registration of individuals, either inadvertently or for fraudulent purposes (col 6, lines 52-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to checking the registration database in Musgrave (151) for duplicates during user registration. One would have been motivated to check for duplicate biometric data in order to prevent users from defrauding the system by opening more than one account with different aliases as disclosed by Houvener.

### *Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Kuhns et al (5,224,173) discloses a method for using biometric identification of users such as welfare recipients. The method checks for duplicate biometric data during the registration process to ensure that the same person is not attempting to obtain welfare benefits under different names (col 6, lines 11-16). This reference could be used in support of the 35 U.S.C. 103 rejection of Claims 11 and 20 above.

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b. Payne (6,072,894) discloses a method for identifying a person applying for multiple bank accounts in an attempt to defraud the banks. The method includes biometric sampling of the applicant, which is then checked against a database of account holders in various banks. This reference could be used in support of the 35 U.S.C. 103 rejection of Claims 11 and 20 above.

c. Piosenka et al (4,993,068) discloses a method for using biometric identification of users through fingerprinting, facial photos, retina scans, voice prints, etc. This reference is cited to show the state of the art in biometric identification at the time the invention was made and could be used in support of a 35 U.S.C. 103 rejection of Claim 12 above.

d. GTE Government Systems Corporation (WO 98/50875) is the world patent based on the same priority document as the two cited Musgrave patents.

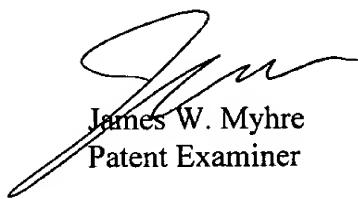
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 2100 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040. Draft faxes may also be submitted directly to the examiner at (703) 746-5544.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-3900.

JWM  
September 5, 2001

  
James W. Myhre  
Patent Examiner